

REMARKS

In response to the Office Action mailed April 24, 2006, Applicants respectfully request reconsideration. To further the prosecution of this application, amendments have been made in the claims, and each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The claims as presented are believed to be in condition for allowance.

Claims 1-45 were previously pending in this application. Claims 1 and 17 are amended herein. Claims 46-54 have been added. No claims have been cancelled. As a result, claims 1-54 are pending for examination, with claims 1, 17 and 33 being independent. No new matter has been added.

Telephone Interview with Examiner

Applicants' representatives thank Examiner Leroux for the courtesies extended in granting and conducting a telephone interview on August 17, 2006. The substance of the interview is summarized herein.

During the interview, Applicants' representatives provided an overview of embodiments of the invention which enable a user to search for information resources, select for preservation one or more resources represented by a search result, and preserve the selected resource(s) in a particular system location. Applicants' representatives explained that embodiments of the invention may be useful, as an example, to an organization involved in a litigation. For example, the organization may search for documents relating to the litigation, and preserve any or all of the documents identified in the search at a particular system location to prevent the documents from being modified or deleted. Due to their preservation at the designated system location, the documents may thereafter be easily located at the system location.

Applicants' representatives indicated that the prior art of record fails to disclose such a system or method, and requested that the Examiner explain how the limitations of the independent claims (in particular, the claimed "preservation") are believed to be met. In this respect, each independent claim is rejected under 35 U.S.C. §102(b) as purportedly being anticipated by U.S. Patent No. 5,222,234 to Wang et al. ("Wang"). Each independent claim recites providing an input

mechanism or method by means of which a user may select for preservation at least one resource; and executing, in response to a user selection, a command to preserve the selected at least one resource in a system location. Wang fails to disclose or suggest these limitations.

No agreement was reached regarding whether the claims (before or after a proposed amendment) distinguish over Wang. The Examiner requested that a written response be filed for his consideration.

Rejections Under 35 U.S.C. §102(b)

Claims 1-45 are rejected under 35 U.S.C. §102(b) as purportedly being anticipated by Wang. Applicants respectfully traverse this rejection, as the independent claims patentably distinguish over Wang.

A. Claims 1-16 and 46-48

As amended to more particularly point out the invention, claim 1 recites a computer-implemented method for facilitating access to a resource included in a data collection. The method comprises, *inter alia*, executing a search query on the data collection to produce at least one search result; after the execution of the search query, providing an input mechanism by means of which a user may select (from among the search results) for preservation at least one resource represented by a search result; and executing, in response to the user's selection, a command to preserve the selected at least one resource in a system location.

Wang fails to disclose or suggest these limitations. Wang discloses a system which enables users to search for documents stored in a shared library, and store the results of a search in a "search results document" (SRD) (see, e.g., col. 7, lines 52-57). Wang discloses that documents are stored in the shared library in accordance with a document object model (depicted in Fig. 2). The model includes an access control model object (ACMO) and document relation object (DRO) (col. 3, line 48 – col. 4, line 5). Wang discloses that the ACMO contains access information relating to a document, including whether it is public, accessible by a limited number of users, or shared (col.

3, lines 48-57). Wang discloses that the DRO describes the logical relationship between a document and other documents, such as a folder (col. 3, line 64 – col. 4, line 5).

The Office Action contends that the ACMO satisfies the claim 1 limitation of providing an input mechanism by means of which a user may select for preservation at least one resource represented by a search result. The Office Action also contends that the DRO satisfies the claim 1 limitation of executing a command to preserve a selected resource represented by a search result in a system location. Neither of these contentions is supported by the reference.

Wang neither discloses nor suggests that the ACMO or DRO enable the preservation of a document identified in a search. Indeed, the only relationship between the document object model (or the objects that comprise it) and the searching capability disclosed by Wang is that the document object model may provide parameters through which documents in the library may be identified in a search (col. 6, lines 53-63). Wang simply discloses nothing at all relating to employing the ACMO or DRO (or any other object in the document object model) to select for preservation a document identified in a search, and certainly it does not disclose preserving such a selected document in a particular system location.

Wang also fails to disclose or suggest that the ACMO or DRO provides any form of input mechanism. Indeed, Wang explicitly states that the ACMO and DRO are established when a document is stored for the first time in the shared library (col. 3, lines 49-50 and 65). The only input mechanism disclosed by Wang is the search command itself.

Accordingly, the ACMO and DRO disclosed by Wang fail to satisfy the claim limitations.

Although the Office Action does not unambiguously say so, it appears to take the position that even if Wang does not explicitly disclose an input mechanism usable to select a resource for preservation in a system location, this capability is inherent in the disclosure of Wang. That is, it appears to suggest that the ACMO, by defining access control information, provides a mechanism which could conceivably be used to preserve a selected resource by preventing others from deleting the resource, and that the DRO, by defining logical relationships between documents, provides a mechanism that could conceivably be used to associate a document with a particular system

location. Drawing such a conclusion requires an extreme leap of faith. Moreover, M.P.E.P. §2112(IV) provides that inherency is an exceedingly difficult standard to meet:

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. (Emphasis added.)

Accordingly, even if the ACMO and DRO might conceivably be used in the manner espoused by the Office Action (which Applicants do not concede), the mere fact that such conceivable uses exist does not come close to satisfying the inherency standard. Unless the system disclosed by Wang must operate to provide an input mechanism usable to select and preserve a resource at a system location, it does not inherently disclose such a capability. Because Wang does not make clear that this capability is necessarily provided, a rejection based on inherency will not stand. As a result, the rejection under 35 U.S.C. §102(b) is improper.

Accordingly, claim 1 patentably distinguishes over the prior art of record, such that the rejection of claim 1 under 35 U.S.C. §102(b) as purportedly being anticipated by Wang should be withdrawn.

Claims 2-16 and 46-48 depend from claim 1 and are allowable for at least the same reasons.

B. Claims 17-32 and 49-51

Claim 17 recites a computer-readable medium encoded with instructions which, when executed by a computer, perform the method of claim 1. For at least the reasons discussed above with reference to claim 1, claim 17 patentably distinguishes over the prior art of record, such that the rejection of claim 17 under 35 U.S.C. §102(b) as purportedly being anticipated by Wang should be withdrawn.

Claims 18-32 and 49-51 depend from claim 17 and are allowable for at least the same reasons.

C. Claims 33-45 and 52-54

Claim 33 recites a system for facilitating access to a resource included in a data collection. The system comprises, *inter alia*, an input controller to provide an input mechanism by means of which a user may select, from at least one search result produced by a search controller, at least one resource from the data collection for preservation; and a command controller to execute, in response to the user's selection provided to the input controller, a command to preserve the selected at least one resource in a system location.

It should be clear from the discussion above with reference to claim 1 that Wang neither discloses nor suggests an input controller to provide an input mechanism by means of which a user may select at least one search result produced by a search controller for preservation in a system location. As a result, claim 33 patentably distinguishes over the prior art of record, such that the rejection of claim 33 under 35 U.S.C. §102(b) as purportedly being anticipated by Wang should be withdrawn.

Claims 34-45 and 52-54 depend from claim 33 and are allowable for at least the same reasons.

New Claims

New claims 46-54 are added to further clarify Applicants' contribution to the art. Claims 46-48, 49-51 and 52-54 depend from claims 1, 17 and 33, respectively.

Each of claims 46, 49 and 52 require that the at least one resource in the data collection of the respective independent claims comprises a document. As discussed above, the prior art of record fails to disclose or suggest preserving at least one selected resource in a system location, and so it necessarily fails to disclose or suggest preserving at least one resource which comprises a document. For at least this reason, each of claims 46, 49 and 52 are patentable over the prior art of record.

Each of claims 47, 50 and 53 requires that the respective independent claim limitation of executing, in response to a user's selection, a command to preserve at least one selected resource

further comprises physically duplicating the selected resource(s) in a system location. As discussed above, the prior art of record fails to disclose or suggest preserving a selected resource in a system location, and so it necessarily fails to disclose or suggest doing so by physically duplicating the resource in the system location. For at least this reason, each of claims 47, 50 and 53 are patentable over the prior art of record.


Each of claims 48, 51 and 54 requires that the respective independent claim limitation of executing, in response to a user's selection, a command to preserve at least one selected resource further comprise preserving the selected resource(s) in the state at which the resource(s) respectively exist at the time a search is executed. Again, the prior art of record fails to disclose or suggest preserving a selected resource, and so it necessarily fails to disclose or suggest doing so by preserving the resource(s) in the state at which the resource(s) existed at the time a search is executed. For at least this reason, each of claims 48, 51 and 54 are patentable over the prior art of record.

Conclusion

In view of the above, Applicants believe the pending application is in condition for allowance.

Dated: August 23, 2006

Respectfully submitted,

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